REMARKS

Claims 1-12 are pending in this patent application, and stand rejected. This application continues to include claims 1-12.

Reconsideration of the rejection of claims 1-12 is respectfully requested.

Claims 1 and 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roy, et al. (U.S. Patent No. 6,496,859 B2) in view of White, et al. (U.S. Patent No. 6,301,012 B1).

The Examiner recognizes that Roy, et al. does not disclose "identifying whether a network port exists for said first printer; and if no such network port exists, then creating a first network printer port for said first printer based on said printer-specific network information for said first printer", which in claim 1 is performed by the workstation, but relies on White, et al. in an attempt to overcome the lack of disclosure in this regard in Roy, et al.

As indicated in White, et al. Figs. 2 and 3; col. 3, ll. 13-18; and column 4, lines 17-22, it is the printer 30 that initiates the process through which ultimately, a *communication port 175 is created by software 50 residing in print server 20* so that printer 30 may be used by client processor, e.g., workstation, 15 , whereas in contrast, in Applicants' claim 1 it is the workstation that initiates the process through which, a network printer port is created by the workstation so that the printer may be used.

Further, in White, et al., as indicated in Figs. 2 and 3, all paths lead to the creation of a communication port 175, and as such, White, et al. does not do so under the condition of "if no such network port exists", as recited in claim 1. In the Final Office Action, at page 10, the Examiner recognizes that "White fails to explicitly recite the limitation 'if no such port exits'," but contends that the system of White, et al. "does determine if the device is new by verifying that an entry for a

printer is not stored", relying on White, et al. column 3, lines 45-57, abstract, column 2, lines 11-28, Figure 3, and column 4, lines 17-27.

Applicants submit, however, that from White, et al. Fig. 1, and column 3, lines 45-57 and column 4, lines 17-27, it is apparent that it is the printer server 20 that makes the determination of newness to the network, not client processor 15, e.g., a workstation. Notwithstanding, however, in White, et al. the determination of whether a device is new to the network, and if new then creating a communication port on server 20, is a totally different approach as compared to the steps of "identifying" and "creating" recited in claim 1. As recited in claim 1, the workstation first performs the step of "identifying whether a network port exists for said first printer" (not whether the printer is new to the network), and next, "if no such network port exists, then creating a first network printer port for said first printer based on said printer-specific network information for said first printer."

Accordingly, for the reasons set forth above, Applicants submit that claim 1 is not rendered obvious by Roy, et al. in view of White, et al.

Claims 6 and 7 depend from claim 1, and are believed patentable in view of their dependence from otherwise allowable claim 1. In addition, claims 6 and 7 are believed patentable in their own right.

For example, claim 7 recites, "The method of claim 1, wherein said discovery packet is a propriety broadcast message *to which only a printer of said designated type on said network will respond.*" (Emphasis added). In rejecting claim 7, the Examiner relies on Roy, et al. column 2, lines 31-43 and column 3, lines 25-37. While Roy, et al. discloses that a user on the network can find devices of a specified class, Roy, et al. does not make its determination in the manner recited in claim 1. In Roy, et al. the discovery packet is in the form of UDP based broadcast packets 70.

Roy, et al., however, does not disclose, teach or suggest that the UDP based broadcast packets are

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proprietary, and thus does not disclose that the discovery packet is a <u>proprietary</u> broadcast message. Accordingly, claim 7 is believed patentable in its own right.

Claim 8 is believed patentable in its present form for substantially the same reasons set forth above with respect to claim 1.

In addition, claim 8 more specifically recites, "identifying whether a network port exists <u>on</u> <u>said computer workstation</u> for said printer; and if no such network port exists, then, creating a first network printer port for said printer based on said printer-specific network information for said printer." As set forth above, the Examiner recognizes that Roy, et al. does not disclose the "identifying" step, but relies on White, et al. for the identifying step. The Examiner recognizes that White, et al. fails to explicitly recite the limitation "if no such port exits", but contends that the system of White, et al. "does determine if the device is new by verifying that an entry for a printer is not stored", relying on White, et al. column 3, lines 45-57, abstract, column 2, lines 11-28, Figure 3, and column 4, lines 17-27.

Notwithstanding the differences between determining whether a printer is new to a network (White, et al.) and identifying whether a network port exists (the present invention) set forth above in discussing claim 1, the aspect of determining newness of a printer to the network performed by printer server 20 in White, et al. has nothing to do with *identifying whether a network port exists* <u>on</u> <u>the computer workstation,</u> (i.e., client processor 15 in White, et al.) for the printer, as recited in claim 8.

Accordingly, for the reasons set forth above, Applicants submit that claim 8 is not rendered obvious by Roy, et al. in view of White, et al.

Claim 9 depends from claim 8, and is believed patentable in view of its dependence from otherwise allowable claim 8. In addition, claim 9 further and patentably defines the present invention over the cited references.

Accordingly, in view of the above, Applicants respectfully request that the rejections of claims 1 and 6-9 under 35 U.S.C. § 103(a) be withdrawn.

Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roy, et al. in view of White, et al. and in further view of Brockway, et al. (U.S. Patent No. 6,789,111).

Claims 2-5 depend, directly or indirectly, from claim 1. Claim 1 is believed patentable for the reasons set forth above, since Brockway, et al. does not fill the deficiencies of Roy, et al. in view of White, et al. with respect to claim 1. Accordingly, claims 2-5 are believed patentable in view of their dependence from otherwise allowable claim 1. In addition, claims 2-5 further and patentably define the present invention over the cited references.

At page 11 of the Final Office Action, the Examiner asserts that both Roy, et al. and Brockway, et al. deal with discovery of network devices such as printers. However, as summarized in the Abstract of Brockway, et al., "A server-client system is configured to automatically detect and install peripheral devices, such as printers, scanners, etc. that are attached to a client." (Emphasis Added).

The Examiner further asserts that it would have been obvious to combine the cited references because Brockway, et al. discloses plug and play on a "client" computer using Windows 2000 that contains a printer spooler. It is respectfully submitted, however, that this supports Applicants' assertion that Brockway, et al. is directed to locally attached printers, rather than network attached printers as in Roy, et al. and White, et al. As disclosed in Brockway, et al., printer 88 of Brockway, et al. is locally attached to I/O ports of the client computer (client 54 in

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Fig. 2 and client 92 in Fig. 3), and <u>not</u> to the network, and the plug and play aspects disclosed in

Brockway, et al. were only applied to locally attached printers, not network attached printers. As

shown in Fig. 2, the plug and play subsystem resides in client 82 to which printer 88 is locally

attached.

In contrast to Brockway, et al., in Roy, et al. client 15 <u>is not</u> locally attached to the printer,

e.g., network devices 35. Rather, in Roy, et al. network devices 35 receive data over the network

45 (Roy, et al. Fig. 1), or with respect to Roy, et al. Figs. 5A and 5B, printers 12, 13 and 14

receive data over the network between PC 11 and the respective printers 12, 13, and 14.

Similarly, the White, et al. printer 55 <u>is not</u> locally attached to client processor 15, but rather,

printer 55 receives job data via network 10. None of Roy, et al., White, et al. or Brockway, et al.

discloses, teaches or suggests how Roy, et al. or White, et al. could be modified to include the

plug and play aspects of Brockway, et al. to apply to a configuration where the printer <u>is not</u>

locally attached to the client computer, as in Roy, et al. and White, et al., nor has the Examiner

demonstrated that, at the time of the present invention, one skilled in the art would have achieved

such a modification.

Although the Examiner asserts that the motivation for combining the references may be

found in either the references themselves or knowledge generally available to one of ordinary skill

in the art, relying upon <u>In re Fine</u>, 5 USPQ2d 1596 (Fed. Cir. 1988), the Examiner has not

provided particular findings as to the reason the skilled artisan, with no knowledge of the claimed

invention, would have selected the particular components from the respective references for

combination in the manner claimed. There was no specific understanding or principle within the

knowledge of a skilled artisan that would have motivated one with no knowledge of Applicants'

invention to make the combination claimed. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir.

2000). See also In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In addition, prior art references in combination do not make the invention obvious unless

something in the prior art references would suggest an advantage to be derived from combining

their teachings. In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983). See also In re GPAC, 35 USPQ2d

1116, 1123 (Fed. Cir. 1995). However, nothing in the respective references disclose, teach, or

suggest an advantage to be derived from combining their teachings.

Accordingly, Applicants respectfully submit that it would not be obvious to one skilled in

the art to combine the teachings of Roy, et al., White, et al. and Brockway, et al.

Accordingly, it is respectfully requested that the rejection of claims 2-5 under 35 U.S.C. §

103(a) be withdrawn.

Claims 10-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Brockway, et al. in view of Roy, et al. and in further view of White, et al. Applicants do not

believe that is would be obvious to combine the cited references for reasons set forth above.

In addition, claim 10 recites, in part, "upon initialization of said port monitor [at the

workstation], said port monitor sending a proprietary broadcast message to which each printer of a

designated type on said network can respond, said each printer of said designated type responding

to said *proprietary broadcast message* with a unique data packet including printer-specific

network information; said port monitor [at the workstation] receiving said printer-specific

network information; and for each identified printer of said designated type for which no port

exists, said port monitor invoking said Add Port mechanism of said Windows print spooler…",

which the Examiner recognizes is not disclosed in Brockway, et al., and in turn, the Examiner

relies on Roy, et al. and White, et al.

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As set forth above, in Roy, et al., the discovery packet is in the form of UDP based

broadcast packets 70. Roy, et al., however, does not disclose, teach or suggest that the UDP

based broadcast packets are proprietary, and thus does not disclose that the discovery packet is a

proprietary broadcast message.

In White, et al. Figs. 2 and 3; col. 3, ll. 13-18; column 4, lines 17-22, it is the printer 30

that initiates the process through which ultimately, a communication port 175 is created by

software 50 residing in print server 20 so that printer 30 may be used by client processor, e.g.,

workstation, 15, whereas in contrast, in Applicants' claim 10 it is the workstation that initiates the

process through which ultimately, a network printer port is created by the workstation so that the

printer may be used. Further, in White, et al., as indicated in Figs. 2 and 3, all paths lead to the

creation of a communication port 175, and as such, White, et al. does not do so under the

condition of if "no port exists", as recited in claim 10.

Accordingly, claim 10 is believed patentable in its present form.

Claims 11 and 12 are believed allowable in view of their dependence from claim 10, and

further patentably define Applicants' invention over the cited references.

Accordingly, it is respectfully requested that the rejection of claims 10-12 under 35 U.S.C.

§ 103(a) be withdrawn.

For the foregoing reasons, Applicants believe that the present application is in condition

for allowance in its present form, and it is respectfully requested that the Examiner so find and

issue a Notice of Allowance in due course.

In the event Applicants have overlooked the need for an extension of time, an additional

extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally

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petition therefor and authorize that any charges be made to Deposit Account No. 20-0095,

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Should any question concerning any of the foregoing arise, the Examiner is invited to

telephone the undersigned at (317) 894-0801.

Respectfully submitted,

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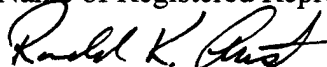Indianapolis, IN 46229
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